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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/998,613	11/30/2001	John Merrow Davies	OPTP101USB	4910

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EXAMINER

ALAM, SHAHID AL

ART UNIT PAPER NUMBER

2162

DATE MAILED: 08/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/998,613

Applicant(s)

DAVIES ET AL.

Examiner

Shahid Al Alam

Art Unit

2162

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2005 (RCE).
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15 - 34 and 37 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 15 - 34 and 37 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 30 November 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This Office action is in response to RCE filed on 15 June 2005.
2. Claims 15 – 34 and 37 are pending in this Office action.
3. In response to Applicants' argument that Notani does not anticipate each and every limitation of applicants' claimed invention (does not teach or suggest each and every limitations in the cited section) (cited location has nothing to do with applicant's invention). Examiner likes to point out that in the "Schering Corp. v. Geneva Pharmaceuticals Inc., 64 USPQ2d 1032 (DC NJ 2002) Decided August 8, 2002."

In the above case it is concluded that the prior art **disclosure need not be express in order to anticipate**. Even if a prior art inventor does not recognize a function of his or her process, the process can anticipate if that function was inherent. To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and **that it would be so recognized by persons of ordinary skill. Inherency is not necessarily coterminous with the knowledge of those of ordinary skill in the art.** Artisans of ordinary skill may not recognize the inherent characteristics or functioning of the prior art. However, the discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art's functioning, does not render the old composition patentably new to the discoverer. Insufficient prior understanding of the inherent properties of a known composition does not defeat a finding of anticipation.

Examiner is entitled to give claim limitations their broadest reasonable interpretation in light of the specification.

During patent examination, the pending claims must be 'given the broadest reasonable interpretation consistent with the specification.' Applicant always has the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 162 USPQ 541,550-51 (CCPA 1969).

Drawings

4. The informal drawing number 11 is not of sufficient quality to permit examination. Accordingly, replacement drawing sheet in compliance with 37 CFR 1.121(d) is required in reply to this Office action. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 32, 33 and 37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claims 32, 33 and 37, the phrase "A method" renders the claim indefinite because it is unclear whether this method is a manual method or a computer implemented method.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 32, 33 and 37 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

MPEP 2106 IV.B.2.(b) A claim that requires one or more acts to be performed defines a process. However, not all processes are statutory under 35 U.S.C. 101. *Schrader*, 22 F.3d at 296, 30 USPQ2d at 1460. To be statutory, a claimed computer-related process must either: (A) result in a physical transformation outside the computer for which a practical application in the technological arts is either disclosed in the specification or would have been known to a skilled artisan, or (B) be limited to a practical application within the technological arts.

MPEP 2106.II.A A process that consists solely of the manipulation of an abstract idea is not concrete or tangible. See *In re Warmerdam*, 33 F.3d 1354, 1360, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994).

Claims 32, 33 and 37 in view of the above cited MPEP sections, are not statutory because they merely recite a number of computing steps without producing any tangible result and/or being limited to a practical application within the technological arts. **The use of a computer has not been indicated.**

This claim does not indicate use of hardware on which the software runs to perform the steps recited in the body of the claim. Software or program can be stored on a medium and/or executed by a computer. In other words the software must be computer-readable. **The use of a computer is not evident in the claim.** MPEP 2106.IV.B.1(a) refers to "computer-readable" medium with computer program encoded on it."

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 15 – 34 and 37 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Number 6,119,149 issued to Ranjit Notani (hereinafter "Notani").

With respect to claim 15, Notani teaches a virtual private supply chain (Notani: Abstract; col. 2, lines. 1-7), comprising:

a data acceptor operable to receive one or more supply chain data items from one or more supply chain members (Notani: col. 14. lines. 40-41 - note that the accessor of Notani is analogous to the acceptor of applicant);

a supply chain data store operable to store one or more supply chain data items received from one or more supply chain members (Notani: col. 5, lines. 32-47 – note that a persistent hierarchy of slots reads on a data store);

a data accessor operable to selectively present one or more supply chain data items stored in the supply chain data store to one or more viewing supply chain members (Notani: col. 4, lines. 17-26; Fig. 8, items 60 and 58 - note the web server implies viewing of data over an Internet browser); and

a component that establishing one or more relationships within the supply chain data store between a first supply chain data item originating from a first supply chain data member and one or more second supply chain data items originating from one or more second supply chain members (Notani: col. 15, lines. 55-58; col. 15, in. 66 to col. 16, line. 10; col. 14, lines. 43-46; col. 14, lines. 56-62 – note that a hub and spoke architecture facilitates establishing relationships of data items).

As to claim 17, an ownership identifier is established within the supply chain data store for one or more supply chain data items (col. 9, lines. 53-54; col. 10, line. 53 to col. 11, line. 11 – note that verify that a partner is who it claims to be, plus ability to collect data grouped by partnership, reads on facilitating establishing an ownership identifier).

As to claim 18, the supply chain data store is further adapted to facilitate establishing one or more access rights to supply chain data items (col. 10, lines. 56-65 – note that setting “read, write, take, and subscribe permissibilities” reads on establishing access rights).

As to claim 19, the data acceptor is further adapted to transform the received supply chain data to conform with one or more supply chain schema (col. 14, lines. 41-42; col. 14, line. 63 to col. 15, line. 2; col. 15, lines. 31-43 - note the transformer conforming to the CDM schema).

As to claim 20, the data acceptor is further adapted to validate the transformed supply chain data (col. 12, lines. 5-17 - note that strong typing inherently reads on data validation since strong typing implies checking for a type mismatch error on incoming data, which in turn reads on data validation).

As to claim 21, the data acceptor is further adapted to load the validated supply chain data into the supply chain data store (col. 5, lines. 32-47; col. 14, lines. 40-48 – note that a persistent hierarchy of slots reads on a data storage and note the accessor, transformer, and transfer objects).

As to claim 22, the data accessor implements row-level supply chain security (col. 10, line. 53 to col. 11, line. 11; col. 9, lines. 44-58 - Note that the ability to separate data rows specific to a collaboration, and further to set security attributes on a per element basis reads on row-level security).

As to claim 23, the row-level supply chain security employs at least one of secure socket layers (SSL), digital certificates and encryption (col. 3, lines. 30-52).

As to claim 24, the one or more supply chain members are configured in a hub and spoke configuration, with the supply chain members located at spokes and at least one of the data acceptor, the data accessor and the supply chain data store located at the hub (col. 3, line. 59 to col. 4, line. 5; Fig. 2).

As to claim 25, at least one supply chain member implements a connection stream (col. 7, lines. 10-19).

As to claim 26, the connection stream is adapted to facilitate making communications between the hub and the spoke implementing the connection appear as a stream (col. 7, lines. 10-19).

As to claim 27, the connection stream is further adapted to facilitate sending, receiving and/or validating BIOs (col. 7, lines. 10-19; col. 11, line. 61 to col. 12, line. 4 – note XML and Java (TM) Serial Streams support transfer of interface formats which reads on the “business interface objects” of applicant and further that “parameterized workflow” read on “business interface objects” of applicant).

As to claim 28, the connection stream is further adapted to facilitate selecting an encryption level to be applied to data communicated between the hub and the spoke implementing the connection stream (col. 10, Table 2).

As to claim 29, one or more supply chain data items may be persisted at one or more spokes (col. 3, line. 46 to col. 4, line. 5 – note that any enterprise, both hub and spoke, that participates in a global collaborations contains its own data).

As to claim 30, the persisted items are stored as BLOBS (Binary Large Objects) (col. 5, lines. 48-56 – note that an “arbitrary byte array” reads on a BLOB).

With respect to claim 31, Notani teaches a computer readable medium storing computer executable components of a virtual private supply chain comprising:

a data accepting component operable to receive one or more supply chain data items from one or more supply chain members (col. 14, lines. 40-41 - note that the accessor of Notani is analogous to the acceptor of applicant);

a supply chain data storing component operable to facilitate storing one or more supply chain data items received from one or more supply chain members (col. 5, lines. 32-38; col. 14, lines. 40-48 – note that a persistent hierarchy of slots reads on a data storage and note the accessor, transformer, and transfer objects); and

a data accessing component operable to selectively present one or more supply chain data items stored by the supply chain data storing component to one or more viewing supply chain members (col. 4, lines. 17-26; Fig. 8, items 60 and 58 - note the web server implies viewing of data over an Internet browser).

With respect to claim 32, Notani discloses: a method for providing a virtual private supply chain between two or more supply chain members, the method comprising:

centralizing supply chain data from a plurality of supply chain members (col. 5, lines. 32-47 - note that the global collaboration workspace reads on centralized data with respect to the collaboration data);

conforming the supply chain data to one or more common schema (col. 14, lines. 41-42; col. 14, line. 63 to col. 15, line. 2; col. 15, lines. 31-43 - note the transformer conforming to the CDM schema); and

selectively permitting access to conformed supply chain data based on row-level security applied to the conformed supply chain data (col. 10, line. 53 to col. 11, line. 11;

col. 9, lines. 44-58 - Note that the ability to separate data rows specific to a collaboration, and further to set security attributes on a per element basis reads on row-level security).

With respect to claim 33, Notani discloses: a method for providing a virtual private supply chain between two or more supply chain members, the method comprising:

accepting one or more supply chain data items from one or more supply chain members (col. 14, lines. 40-41 - note that the accessor of Notani is analogous to the acceptor of applicant);

establishing one or more ownership identifiers for the supply chain data items (col. 9, lines. 53-54; col. 10, line. 53 to col. 11, line. 11 – note that verify that a partner is who it claims to be, plus ability to collect data grouped by partnership, reads on facilitating establishing an ownership identifier);

transforming the supply chain data items to conform with one or more supply chain schema (col. 14, lines. 41-42; col. 14, line. 63 to col. 15, line. 2; col. 15, lines. 31-43 - note the transformer conforming to the CDM schema);

validating the transformed supply chain data items (col. 12, lines. 5-17 - note that strong typing inherently reads on data validation since strong typing implies checking for a type mismatch error on incoming data, which in turn reads on data validation);

storing the validated supply chain data items in a supply chain data store (col. 5, lines. 32-47; col. 14, lines. 40-48 – note that a persistent hierarchy of slots reads on a data storage and note the accessor, transformer, and transfer objects);

establishing one or more relationships between supply chain data items received from two or more supply chain members (col. 4, lines. 27-40); and

selectively permitting access to one or more supply chain data items based on at least one of the ownership of the supply chain data item, the one or more relationships associated with the supply chain data items, and the one or more access permissions associated with the supply chain data items (col. 10, lines. 56-65 – note that setting “read, write, take, and subscribe permissibilities” reads on establishing access rights).

As to claim 34, a computer readable medium storing computer executable instructions operable to perform the method of Claim 33 (col. 17, lines. 9 – 10).

With respect to claim 37, Notani discloses a method for providing a virtual private supply chain between two or more supply chain members, the method comprising:

means for collecting supply chain data from a plurality of supply chain members (col. 14, lines. 40-41 - note that the accessor of Notani '149 is analogous to the acceptor of applicant);

means for standardizing the collected supply chain data to one or more supply chain schema (col. 14, lines. 41-42; col. 14, line. 63 to col. 15, line. 2; col. 15, lines. 31-43 - note the transformer conforming to the CDM schema which is a standardizing schema); and

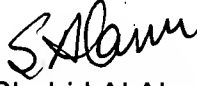
means for securely accessing the collected supply chain data (col. 3, lines. 30-52 – note SSL reads on secure access).

Contact Information

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shahid Al Alam whose telephone number is (571) 272-4030. The examiner can normally be reached on Monday-Thursday 8:00 A.M.- 4:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Shahid Al Alam
Primary Examiner
Art Unit 2162

21 August 2005